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SUGHRUE MION, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037			EXAMINER AUSTIN, SHELTON W	
			ART UNIT	PAPER NUMBER
			2623	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/917,896

Applicant(s)

MICHAEL ET AL.

Examiner

Shelton Austin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 06/22/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that "one of ordinary skill in the art, at the time the invention was made, would not have been motivated to modify the references [Voit in view of Palmer]" because "Voit requires an advanced intelligent network (AIN) having a very particular configuration of component parts" and that "[s]uch a modification would...require a substantial reconstruction and redesign of the component elements of Voit" and "[f]urther, modifications requiring such a substantial reconstruction and redesign of the component elements have been held to be indicative of nonobviousness" (page 3, second paragraph of Applicant's Remarks), it is pointed out that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Palmer suggests to those of ordinary skill in the art "the intercept unit obtains further data comprising prior call information on a caller in dependence on the intercepted data."

In response to applicant's argument that "if one of skill in the art were to arbitrarily add additional component parts in order to achieve the modification...the 'efficient

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transport' of Voit would certainly be affected in a negative way" (page 3, third paragraph and page 4, first paragraph), the examiner points to Voit, col. 5, lines 3-7, "there is a need for techniques that will allow efficient transport of call related information to a subscriber's CPE" in which modifying Voit by adding a "log file" in order to obtain prior call information as taught by Palmer would not at all effect the "efficient transport" of Voit in a negative way and would enhance the efficiency by retrieving caller information more readily by having the information stored in the file.

In response to applicant's arguments against the references individually ("the architecture of Palmer is completely different from the claimed invention", "in Palmer, the telephone device is attached to the HFC network, whereas the claimed invention can be applied to any telephone device" and "[the] system of Palmer only applies to those telephony services offered through an HFC type network" [page 4, paragraphs 2-4 and page 5, paragraph 1 of Applicant's Remarks]), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, the limitations that the applicant has mentioned (e.g. "whereas the claimed invention uses the HFC network simply for client server communications", "the claimed invention can be applied to any telephone device" and "the claimed invention can provide services to any type of telephony subscriber") are not recited in the claim language. In addition, the examiner uses Palmer solely to teach the limitation, "the intercept unit obtains further data comprising prior call information on a caller in dependence on the intercepted data."

Further, the applicant argues “[t]herefore...one of ordinary skill in the art at the time the invention was made would not have been motivated to modify the applied references” and that “any such a suggestion is only found within the disclosure of the present application”, thereby “the Examiner’s argument impermissibly relies on hindsight reasoning” (page 5, second paragraph). In response to applicant’s argument that the examiner’s conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Again, Palmer is used to teach “the intercept unit obtains further data comprising prior call information on a caller in dependence on the intercepted data”, which is not only found within the disclosure of the present application but within the disclosure of Palmer as indicated below.

Thus, claim 1 thus fails to distinguish over the cited art for the reasons discussed above; the rejection is therefore maintained.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voit et al. (US 5,805,682) in view of Palmer et al. (US 2001/0038690).

Regarding claim 1, Voit et al. ("Voit") discloses the a system for providing signals to a television receiver of a user within a television network, the system comprising: an intercept unit connected to a telephone network and intercepting data concerning a telephone call being made to a user's telephone number (Signal Switching Point 11, col. 9, lines 15-20), communicating the data over the television network to the television receiver of the user (col. 10, lines 25-27, which disclose a "send data" transaction, with the calling name and calling number being sent to the set-top box (DET) of customer A), wherein the television receiver of the user displays the data concerning the telephone call on a television screen associated with the television receiver of the user (col. 10, lines 32-40). Voit, however, fails to disclose the intercept unit obtains further data comprising prior call information on a caller in dependence on the intercepted data.

In an analogous art, Palmer discloses an intercept unit (headend/CMS) that obtains data comprising prior call information (log file) on a caller in dependence on intercepted call data (caller ID; paragraphs 56, 57, 59), thereby enabling automatic call handling while the user is busy (paragraph 62).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Voit to include obtaining further data comprising prior call information on a caller in dependence on the intercepted data, as taught by Palmer, for the benefit of reducing unwanted interruption experienced by the user.

Regarding claim 2, Voit and Palmer together teach the claimed system according to claim 1. Voit further teaches the claimed limitations as follows: "service transmission system communicating with the television network" is met by the ISCP (Integrated Service Control Point) 15 connected to the television broadband network 21 through interface point 17 [col. 8, lines 48-50]; "intercept unit communicating the data concerning the telephone call to the service transmission system" is met by the SSP 11 composing and sending a TCAP query to the ISCP 15 with the calling number of the incoming call [col. 9, lines 15-25]; "service transmission system formatting the data into a television signal and communicating the television signal over the television network to the television receiver of the user" is met by column 10, lines 19-44, which disclose a "send data" transaction, with the calling name and calling number being sent to the set-top box (DET) of customer A from the ISCP 15.

Regarding claim 3, Voit further the claimed "system according to claim 2, in which the intercept unit communicates data to the service transmission system via one of the Internet and a telecommunications network" is met by the SS7 signaling connection [col. 8, lines 60-67].

Regarding claim 4, Voit further discloses: "database cross-referencing user telephone numbers with data on the television receiver of the user" is met by the "stored internal data", which cross-references the received telephone number with the video network address of the set-top box of the called customer [col. 6, lines 15-16 & col. 10, line 29]; the claimed "intercept unit communicating the telephone number of the user to the service transmission system" is met by the SSP 11 composing and sending a TCAP query to the ISCP 15 with the calling number of the incoming call [col. 9, lines 15-25]; the claimed "service transmission system accessing the database to obtain the data on the television receiver of the user, and using the data on the television receiver of the user to communicate the television signal to the television receiver of the user" is met by the fact that the ISCP accesses the stored internal data as discussed in column 6, lines 15-16 and column 10, line 29 to obtain the video network address of the set-top box of the called customer. The video network address is then used to perform a "send data" transaction, with the calling name and calling number being sent to the set-top box (DET) of customer A from the ISCP 15 [col. 10, lines 26-29].

Regarding claim 5, Voit further discloses: "service transmission system embeds the data concerning the telephone call within a television program to be broadcast to the • television receiver of the user" is met by column 10, lines 26-29, which disclose that the video network address is used to perform a "send data" transaction, with the calling name and calling number being sent to the set-top box (DET) of customer A from the

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ISCP 15 [col. 10, lines 26-29]; "data concerning the telephone call being displayed within the television program on the television screen of the user" is met by the fact that the Caller ID message is displayed at the bottom of the screen on TV 27 [col. 10, lines 32-40].

Regarding claim 6, see the above rejection of claim 5.

Regarding claim 7, the claimed "system according to claim 2, wherein the data concerning a telephone call includes a caller's calling line indicator" is met by the LIDB discussed in column 10, lines 19-29, which provides further information related to the calling number.

Regarding claim 8, the claimed "system according to claim 2, wherein the intercept unit obtains further data on a caller in dependence on the intercepted data concerning the telephone call and communicates the data concerning the telephone call and the further data to the service transmission system for communication to the user's television receiver" is met by the LIDB being used to get the user's name and other further information associated with the user's calling number, the call related information being the same information typically provided in a conventional telephone caller ID service [col. 10, lines 19-29]. The caller ID information is then send to the set-top box associated with the called customer.

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Regarding claim 9, the claimed "system according to claim 2, wherein the service transmission system obtains further data on a caller in dependence on the data concerning the telephone call communicated by the intercept unit and formats the data concerning the telephone call and the further data into a television signal for communication to the user's television receiver" is, again, met by column 10, lines 1.9-29, which have been thoroughly discussed above.

Regarding claim 10, the claimed "system according to claim 2, wherein the service transmission system obtains further data on a caller in dependence on the data concerning the telephone call communicated by the intercept unit and replaces the data concerning the telephone call with the further data prior to formatting the data into a television signal for communication to the user's television receiver" is, again, met by column 10, lines 19-29, which have been thoroughly discussed above.

Regarding claim 11, the claimed "system according to claim 9, further comprising a database of information on known callers, the service transmission system obtaining the further data from the database of information on known callers" is, again, met by column 10, lines 19-29, which have been thoroughly discussed above.

Regarding claim 12, the claimed "system according to claim 9, wherein the service transmission system communicates with a telephone service provider's

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database and obtains the further data from the telephone service provider's database" is, again, met by column 10, lines 19-29, which have been thoroughly discussed above.

Regarding claim 13, Voit further discloses: "receiver accepts an input from a user in response to the data displayed on the television screen and communicates the input to the service transmission system" is met by the customer entering a response to the DET 25, which is forwarded to the ISCP 15. The response may indicate the customer's preferred disposition of that call [col. 10, lines 37-44]; "service transmission system managing the call in dependence on the input" is met by the ISCP caring for the call according to the customer's preferred disposition of that call [col. 10, lines 43-44 & col. 11, lines 6-13].

Regarding claim 14, the claimed "system according to claim 13, wherein the input is a command to redirect to a voicemail system, the service transmission system communicating with the intercept unit to redirect the call to the voicemail system" is met by the fact that the user can select a response to deal with the incoming call. The example of directing the call to a voicemail system is given [col. 11, lines 3-13].

Regarding claim 15, the claimed "system according to claim 13, wherein the input is a command to send a message to a caller, the service transmission system communicating with a messaging system to send the message to the caller" is, again,

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met by the fact that the user can select a response to deal with the incoming call [col. 11, lines 3-13].

Regarding claim 16, the claimed "system according to claim 15, wherein the message is one of: an instant message or an email" is, again, met by the fact that the user can select a response to deal with the incoming call [col. 11, lines 3-13].

Regarding claim 17, the claimed "system according to claim 1, wherein the television receiver is a digital television decoder" is met by the DET (also referred to as a set-top box) discussed in column 8, lines 20-23 and throughout the reference.

Regarding claim 18, the claimed "system according to claim 17, wherein the decoder is a set-top-box" is met by the DET (also referred to as a set-top box) discussed / in column 8, lines 20-23 and throughout the reference.

Regarding claim 19, see the above rejection of similar claim 1.

Regarding claim 20, see the above rejection of similar claim 2.

Regarding claim 21, see the above rejection of similar claim 4.

Regarding claim 22, see the above rejection of similar claim 5.

Regarding claim 23, see the above rejection of similar claim 8.

Regarding claim 24, see the above rejection of similar claim 10.

Regarding claim 25, see the above rejection of similar claim 11.

Regarding claim 26, see the above rejection of similar claim 12.

Regarding claim 27, see the above rejection of similar claim 13.

Regarding claim 28, see the above rejection of similar claims 14-16.

Regarding claim 29, see the above rejection of similar claim 1.

Regarding claim 30, see the above rejection of similar claim 1.

Regarding claim 31, see the above rejection of similar claim 2.

Regarding claim 32, see the above rejection of similar claim 4.

Regarding claim 33, see the above rejection of similar claim 5.

Regarding claim 34, see the above rejection of similar claim 8.

Regarding claim 35, see the above rejection of similar claim 10.

Regarding claim 36, see the above rejection of similar claim 11.

Regarding claim 37, see the above rejection of similar claim 12.

Regarding claim 38, see the above rejection of similar claim 13.

Regarding claim 39, Voit and Palmer together disclose the claimed "user interface for a television" is met as applied above. Voit further discloses: "object for receiving an incoming telephone call indication signal based on intercepted call data" is met by the DET receiving the call related information [col. 10, lines 32-37]; "display region, responsive to said incoming telephone call indication signal, displaying an incoming telephone call indication based on said incoming telephone call indication signal" is met by the Caller ID message being displayed at the bottom of the screen on TV 27 [col. 10, lines 38-44].

Regarding claim 40, Voit further discloses: "a user activatable region for sending a prior call information access request" is met by signaling message displayed on the

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television indicating to the user that there is a list of "missed calls" waiting to be viewed [col. 10, lines 1-11].

Regarding claim 41, Voit further discloses: "object for receiving a prior call ~ information signal" is met by the ISCP sending information regarding the missed calls to the DET upon request by the user [col. 10, lines 1-11]; "display region displaying prior call information based on said prior call information signal" is met by the inherent display of the requested missed call list [col. 10, lines 1-11]. When the user requests to view the list, it needs to be displayed.

Regarding claim 42, see Voit: "interface as set fourth in claim 39, wherein the incoming call indication signal comprises system-provided incoming Call information and supplemental incoming call information" is met by the fact that the incoming call information consists of a calling name and a calling number [col. 10, lines 25-30].

Regarding claim 43, the claimed "interface as set fourth in claim 42, further comprising a display region displaying said supplemental incoming call information" is met by the Caller ID message being displayed at the bottom of the screen on TV 27 [col. 10, lines 38-44].

Regarding claim 44, the claimed "interface as set fourth in claim 39, further comprising a user activatable region for indicating a call management function relating

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to incoming telephone calls of said user" is met by the fact that the user can select a response to deal with the incoming call [col. 11, lines 3-13].

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelton Austin whose telephone number is (571) 272-9385. The examiner can normally be reached on Monday through Thursday from 8:00-5:30. The examiner can also be reached on Fridays from 9:00-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant, whose telephone number is (571) 272-7294, can be reached on Monday through Friday from 7:30-5:00. The supervisor can also be reached on

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alternate Fridays from 9:00-4:00. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shelton Austin
10/01/2007


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